



Attorney Docket # 4925-104RCE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Jukka SUONVIERI

Serial No.: 09/786,331

Filed: March 1, 2001

For: A Method and a System for Detecting
Communication Relaying Network Elements

Examiner: Cho, Un C.
Group Art: 2687

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

January 25, 2007

(Date of Deposit)

Alphonso A. Collins

Name of applicant, assignee or Registered Representative

Signature

January 25, 2007

Date of Signature

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicant requests review of the Final Rejection in the above-referenced application. No amendments are being filed with this request.

The review is requested for the reasons set forth on the following pages.

In the November 17, 2006 Final Office Action, independent claims 21, 33 and 38, and dependent claims 22, 25, 26, 28, 29, 31, 33 and 39-41 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,822,314 ("*Chater-Lea*"). Dependent claims 30 and 37 were rejected under 35 U.S.C. §103(a) as unpatentable over *Chater-Lea* in view of U.S. Patent No. 5,987,513 ("*Prithviraj*"). Dependent claim 32 was rejected under 35 U.S.C. §103(a) as unpatentable over *Chater-Lea* in view of U.S. Patent No. 6,507,741 ("*Bassirat*"). For the following reasons, reconsideration of the rejections is respectfully requested.

The Office Action (pg. 6, ¶ 6) states:

Chater-Lea discloses a method for detecting network elements relaying communications between a base station and a mobile station in a mobile network ... comprising:

...

determining whether a communication was relayed via at least one of the network elements by detecting an increased time delay as compared to a known time delay of mobile stations communicating directly with the base stations (communication between first and second mobile communication is relayed through a relay, whereas the relay adds delay to the communication between the first and second communication device, thus producing a timing offset; *Chater-Lea*: Col. 2, lines 15-20 and Col. 2 line 52 through Col. 3, line 10)....

With respect to the foregoing, Applicant respectfully asserts that *Chater-Lea* fails to teach the method recited in independent claim 21. *Chater-Lea* discloses a solution for obtaining timing pursuant to synchronization between two communication units, i.e., a base station and a mobile station (see col. 1, lines 5-7). That is, *Chater-Lea* is directed to obtaining the necessary synchronization upon the start-up of a communication link between a mobile station and a base station so as to enable initiation of an encryption process.

Chater-Lea (col. 2, lines 15-20) states, "the timing offset is indicative of the combined timing delay for transmissions from the first communications unit via the relay device to the second communications unit and from the second communications unit via the relay device to the first communications unit".

Chater-Lea, however, fails to teach the determining step recited in independent method claim 1. *Chater-Lea* (col. 2, lines 15-20) states, "the first communications unit receives the second timing signal, calculates a timing offset between the timing of the received second timing signal and the timing information contained within the received second timing signal".

Applicant respectfully asserts that it is not possible to deduce from timing advance comparisons whether one or more relaying elements are used between a mobile and a base station. Rather, what *Chater-Lea* does teach is that a frame number comparison is used to define a timing offset to compensate for variations in a transmission. There is nothing with respect to determining whether a communication was relayed through a particular network element. *Chater-Lea* is directed to the synchronizing the base station with the mobile station. In fact, *Chater-Lea* fails to provide the slightest hint, motivation or suggestion that the presence of relaying elements or that relaying elements are even identified or could even be identified. Such a determination requires more than merely detecting the presence of some random element (see dependent claim 22). Naturally, a person having the ordinary level of skill in the art would readily appreciate that relaying elements would add delay, which would naturally affect the offset/synchronization process. However, which relaying element? *Chater-Lea* fails to teach that such a determination is made. Moreover, *Chater-Lea* fails to provide any indication that relaying elements could be identified by a difference in timing advance values, as defined by independent claim 21. *Chater-Lea* fails to provide even the slightest hint of how to distinguish between a “normal” delay (i.e. delay caused by direct transmission between two communication units with a relay located between them) and “relay specific delay (i.e. indicating that there is a relay between the two communication elements). Consequently, independent claim 21 is patentable over *Chater-Lea* for at least this reason.

Secondly, a base station does NOT constitute part of a network management system (NMS). The skilled person would readily appreciate such a fact. However, the Examiner (pg. 3 of the Office Action) asserts the mobile station sends an event notice (e.g., a frame number) to the base station. As described at pgs. 3, 6 and 9 of the originally filed specification and Fig. 7(a) and 7(b), it is a base station or the base station controller (BSC or RNC) that actually sends an event notice to the NMS. *Chater-Lea* is dissimilar to Applicant’s claimed invention, because *Chater-Lea* teaches that the base station is the receiving entity. Therefore, within the context of the claimed it is clear that the NMS is separate from the BSC/BS (see e.g., Figs. 7a, 7b and related text). It follows that *Chater-Lea* fails to teach the step of “sending an event notice to a network management system, when a presence of at least one of the network elements is initially detected”.

Regarding independent claim 38, *Chater-Lea* cannot teach the claimed invention, since independent claim 38 is directed to the network element which implements the method of

independent claim 21. Therefore, the claimed invention is patentable over *Chater-Lea* for at least this additional reason. In view of the foregoing, reconsideration and withdrawal of the rejection under 35 U.S.C. §102 is requested, and a notice to that effect is solicited.

The Examiner cites *Prithviraj* to cure the deficiency of *Chater-Lea*, i.e., the failure to teach or suggest "monitoring the communication relayed via at least one of the network elements to determine various parameters which provide information with respect to network functionality and the network elements". *Bassirat* has been cited based on the failure of *Chater-Lea* to teach or suggest "at least one of said network element is an optical tunneling configuration." *Prithviraj* fails to teach the determining step recited in independent claim 21. *Prithviraj* fails to cure the deficiency of the *Chater-Lea* patent. *Bassirat* fails to teach or suggest the determining step or the sending step of independent claim 21. *Bassirat* therefore fails to cure the deficiencies of the combined *Chater-Lea* and *Prithviraj* patents, since *Bassirat* also fails to teach at least the determining step recited in independent method claim 21.

In view of the foregoing, independent claim 21 is patentable over the combination of *Chater-Lea*, *Prithviraj* and/or *Bassirat*. Therefore, reconsideration and withdrawal of all the rejections under 35 U.S.C. §103(a) are in order, and a notice to that effect is respectfully requested.

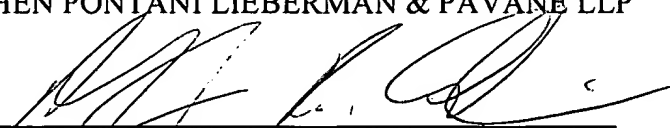
Independent claims 33 and 38 are system claims associated with the method of independent claim 21. Accordingly, independent claims 33 and 38 are patentable over the combination of the cited references for the reasons discussed above with respect to independent method claim 21.

In view of the patentability of independent claims 21, 33 and 38, for the reasons set forth above, dependent claims 22, 25, 26, 28-32, 35, 37, and 39-41 are all patentable over the prior art.

Applicant respectfully submits that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By


Alphonso A. Collins
Reg. No. 43,559
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: January 25, 2007